

REMARKS

This communication is in response to the Office Action mailed October 11, 2007. Claims 1-5 are pending in the present application. Of the above, claims 4-5 have been withdrawn from consideration, and claim 1 has been amended to appropriately claim the subject matter by reciting the steps of the method. The amended claim 1 finds support throughout the specification, but specifically, at pages 12-21 of the specification. Accordingly, no new matter has been introduced by these amendments.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. For the reasons discussed herein, Applicants respectfully traverse the Examiner's rejections and request that the Examiner reexamine and reconsider patentability of the pending claims based on the amendments and arguments herein.

Rejection under 35 U.S.C. § 112, first paragraph

The Examiner rejected claims 1-3 under 35 U.S.C. § 112, first paragraph, because the specification allegedly does not reasonably provide enablement for a process for preparing aromatic carbonate other than the specific compounds disclosed in the specification, i.e., compounds of formula 1, 2 or 3. Applicants respectfully traverse.

If everything in the specification were required to be read into the claims, or if structural claims were to be limited to devices operated precisely as a specification-described embodiment is operated, there would be no need for claims. Nor could an applicant, regardless of the prior art, claim more broadly than that embodiment. Nor would a basis remain for the statutory necessity that an applicant conclude his specification with 'claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his

invention.' 35 U.S.C. § 112. It is the claims that measure the invention.

SRI International v. Matsushita Elec. Corp., 775 F.2d 1107, 227 U.S.P.Q. 577 (Fed. Cir. 1985) (en banc).

The enablement requirement does not require the Applicants to claim only the embodiments described in the specification. In fact, the enablement is satisfied as long as the specification describes the invention in such terms that one skilled in the art can make and use the full scope of claimed invention without undue experimentation. *Chiron Corp. v. Genentech, Inc.*, 363 F.3d 1247, 1253 (Fed. Cir. 2004).

The present application is enabling because one skilled in the art would not have to engage in undue experimentation to make or use the claimed invention since the transesterification process using a dialkyl carbonate or alkyl aryl carbonate compound and an aromatic hydroxyl compound as starting materials in the presence of a catalyst is well within the purview of any chemist. (See BACKGROUND SECTION of the specification). Accordingly, Applicants respectfully request that the rejection be withdrawn.

Rejection under 35 U.S.C. § 102 (b)

The Examiner rejected claims 1-3 under 35 U.S.C. § 102(b) as being anticipated by *Rechner et al.* (US 5,523,451) or by *Komiya et al.* (US 5,872,275).

To establish a *prima facie* case of anticipation under Section 102(b), each and every element set forth in the claims must be either expressly or inherently described in a single prior art reference, and the identical invention must be shown in complete detail, as is contained in the claims. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999).

Rechner et al. is directed to a process of making aryl carbonates using multiple bubble column reactors that are

connected in series to increase the space-time yield (STY). As mentioned in the BACKGROUND SECTION of the present application at page 4, *Rechner et al.* teaches a process wherein the catalyst is moved throughout the system with the reactant, which (1) causes difficulties in the separation of the catalysts from the final product, and (2) requires the continuous addition of the catalyst to compensate for the amount withdrawn along with the final product.

Similarly, *Komiya et al.* is directed to a process of producing aromatic carbonates, wherein the catalyst is circulated throughout the system with the reactant, requiring the continuous addition of the catalyst to compensate for the amount withdrawn to maintain a weight ratio of at least one aromatic group containing substance to the metal of the metal-containing catalyst must be maintained at 2.0 or less.

To the contrary, the claimed process, as amended herein, requires that the heterogeneous catalyst is affixed on a carrier inside the reactor, and requires the filtering of the reacted solution to prevent the circulation of the heterogeneous catalyst in the system.

Simply put, both *Rechner et al.* and *Komiya et al.* do not disclose the recited steps of (1) providing a heterogeneous catalyst fixed in place on a carrier, and (2) filtering the reacted solution to provide a filtered solution which is free of the heterogeneous catalyst.

Because *Rechner et al.* and *Komiya et al.* fail to teach each and every limitation as set forth in all of the pending claims, either expressly or inherently, Applicants respectfully request the Examiner to withdraw the rejection based on *Rechner et al.* and *Komiya et al.* under 35 U.S.C. § 102(b).

Rejection under 35 U.S.C. § 103(a)

The Examiner rejected claims 1-3 under 35 U.S.C. § 103(a) as being obvious over *Rechner et al.* or *Komiya et al.*

To establish a *prima facie* case of obviousness under Section 103, the references relied upon for rejection must suggest the entirety of the claimed invention and, hence, "the prior art reference (or references when combined) must teach or suggest all the claim limitations." *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991)

As mentioned above, *Rechner et al.* and *Komiya et al.* fail to teach or suggest all the claim limitations since there is absolutely no teaching, suggestion, or motivation as to immobilization of the heterogeneous catalyst on a carrier and the use of a filter to ensure that the filtered solution, which will be subjected to a separation step, does not contain the heterogeneous catalyst.

The Supreme Court of the United States in *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1732 (2007), recognized that "[w]hen there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp." (emphasis added). In such circumstances, "the fact that a combination was obvious to try might show that it was obvious under § 103." *Id.* However, that is not the case here.

There is no "finite number of identified, predictable solutions" suggested in both *Rechner et al.* and *Komiya et al.* In fact, both *Rechner et al.* and *Komiya et al.* teaches away from the claimed process since they both teach a process wherein the catalyst is circulated throughout the system with the reactant, requiring the continuous addition of the catalyst to compensate for the amount withdrawn along with the final product.

Therefore, Applicants respectfully submit that the claims as amended herein are patentable over *Rechner et al.* or *Komiya et al.*

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he/she telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

By 

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